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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 50N3175.02	
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] 10/13/2009 On _____ Signature <u>Karin L. Williams</u> Typed or printed Karin L. Williams E-mail _____		Application Number 10/725,149	Filed 12/01/2003
		First Named Inventor Takashi Nakatsuyama	
		Art Unit 2624	Examiner Jun Fei Zhong
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the		<u>Karin L. Williams</u> Signature	
<input type="checkbox"/>	applicant/inventor.	Karin L. Williams Typed or printed name	
<input type="checkbox"/>	assigned of record of the entire interest See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	908-518-7700 Telephone number	
<input type="checkbox"/>	attorney or agent of record. Registration number _____	10/13/2009 Date	
<input checked="" type="checkbox"/>	attorney or agent acting under 37 CFR 1.34 Registration number if acting under 37 CFR 1.34 <u>36721</u>		
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input checked="" type="checkbox"/> Total of 1 forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to be (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting this completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**Reasons for requesting pre-appellate review:**

Claims 1-14 are pending in the application, Claims 1, 7 and 14 being independent claims.

Claims 1-2, 6, and 15-16 were rejected under 35 USC 102(b) as being anticipated by US Patent 5,659,350 (Hendricks '350); Claims 7-9, 11-14 and 17-20 (Claims 15-20 were previously canceled) were rejected under 35 USC 102(c) as being anticipated by US Patent 7,134,131 (Hendricks '131.); Claims 3-4 were rejected under 35 USC 103(a) as being unpatentable over Hendricks '350 in view of US Patent 6,178,447 (Wannenmacher et al.) and Claims 5 and 10 were rejected as being unpatentable over Hendricks '350 in view of US Patent 6,005,597 (Barrett et al.).

The Examiner's reasoning does not meet the burden of establishing a *prima facie* case of anticipation. As explained in Applicant's specification as filed, in a method according to Applicant's teachings, "index data is continuously and repeatedly broadcast over the entire area" (para. [0049]) – and "receiver 40 is alerted that tuning data 104 follows on index data signal 34 when it detects its identifier 102" – "receiver 40 then downloads tuning data 104, stores the tuning data in memory 68 and uses the tuning data to receive information the user requested in user profile data 16" (para. [0051]). Hendricks '350 fails to teach or suggest each of these features.

**Independent Claim 1**

Specifically, independent Claim 1 is directed to a method for receiving in a broadcast system, at a receiver having a unique identification number, only designated information, the method including the steps of: monitoring a broadcast index signal containing tuning data, detecting the unique identification number associated with the receiver in the broadcast index signal, downloading the tuning data subsequent to detecting the unique identification number in the detecting step, storing the downloaded tuning data in memory and tuning and receiving a program signal containing program data associated with a program using the tuning data stored in the storing step.

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Applicant respectfully submits that Hendricks '350 fails to teach or suggest a method for *monitoring(at a receiver having a unique identification number) a broadcast index signal containing tuning data, AND then downloading only designated information (at the receiver having a unique identification number) upon 'detecting the unique identification number associated with the receiver, in the broadcast index signal'.*

The Office Action (page 4, second full paragraph) now deletes the previously recited "transmitting" from the previously recited "detecting and/or transmitting" allegedly taught by Hendricks '350.

Again Applicant submits that Hendricks '350 may include a "set top terminal identifier 928" in program information signal 276. it does not teach, or even suggest, that the program information signal 276 is "*monitored*" by the receiver – such that the corresponding set top detects the unique identification number, and only then downloads the tuning data. Applicant respectfully submits that even if Hendricks '350 describes 'transmitting' identifier 928 – it does not teach or suggestion Applicant's claimed limitation of 'detecting'.

The "data format 920" shown in Fig. 6a-6b of Hendricks '350 includes a "set top terminal identifier 928 that *includes a polling command/response (or P/F) bit 930*". This P/F bit is simply used "to command a polling response 920" (FIG. 6b) from the set top terminal 220 addressed" (col. 21, lines 4-5, emphasis added herein).

Set top terminal 220 does not "monitor" signal 276 to detect identifier 928.

For support of the "monitoring" step recited in Claim 1, the Final Action again directs Applicant to col. 9, lines 42-60 of Hendricks '350 which describes only the 'poll-back responses' which allow network controller 214 to maintain accurate billing information. Likewise, Col. 17, lines 50-60 of Hendricks '350 describe TABLE A, which illustrates information that *can be sent* in the program control information signal to set top terminals – this does not suggest monitoring a signal for a unique identification number. Applicant is also directed to Col. 19, lines 30-41 of Hendricks '350, which describe TABLE B, or an "events table" that may be downloaded to a set top terminal. And finally, Applicant is directed to col. 20, lines 50-58, describing Figs. 6a and 6b of Hendricks '350, showing a data format for a program information signal, which includes a set top terminal identifier 928.

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Again, Applicant respectfully submits that *none* of these sections of Hendricks '350 teach or suggest '*monitoring* a broadcast signal containing tuning data" - such that the set top, subsequent to detection of the unique identification number in the broadcast signal, downloads and stores the tuning data. Hendricks '350 does not teach or suggest at least this element of independent Claim 1.

The Final Action, in response to Applicant's previous arguments (para. bottom of page 2-top of page 3 of the Action), states that "Hendricks ('350) discloses using a 4-bit address or a 16-bit set top terminal identifier in the information signal 276 sends from headend to set top terminal. And the information signal 276 is designates to specify set top terminal only (see col. 20, line 50 - col. 21, line 15)".

Again, *set top terminal 220* does not "monitor" signal 276 to detect identifier 928 - rather, P/F bit 930 (of set top terminal identifier 928) is simply used "to command a polling response" from the set top terminal 220 addressed (col. 21, lines 4-5).

As explained at col. 36, lines 7-11, after packaging, the packaged television program signal is prepared for satellite transmission and sent from the operations center 202 to the cable headend 208 via satellite 206. Signals are transmitted "to the cable headend 208 where a computer system including a digital switch treats the signal and delivers it through cables to a subscriber's home" (col. 36, lines 52-55).

There is absolutely no teaching or suggestion in Hendricks '350 that the set top terminal at the subscriber's home 'monitors' signal 276 for a unique identification number.

For at least the foregoing reasons, Applicant again respectfully submits that independent Claim 1 is patentable over Hendricks '350 and reconsideration is requested.

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Independent Claim 7

Independent Claim 7 is directed to a method for requesting and receiving designated information in a broadcast system, at a transceiver having a unique identification number, the method including the steps of: transmitting to a wireless communication system a request signal, the request signal including the unique identification number and a request for a program; receiving from the wireless communication system a broadcast index signal containing the unique identification number associated with the receiver and tuning data; storing the tuning data in memory; and receiving a program signal containing program data, associated with a program, using the stored tuning data.

The Final Action directs Applicant to "col. 41, line 48-col. 45, line 20" of Hendricks '131 as providing support for the recited step of "receiving from the wireless communication system a broadcast index signal containing the unique identification number associated with the receiver and tuning data". Applicant respectfully submits that this cited section of Hendricks '131 (and the remainder of Hendricks '131) fails to teach or suggest receiving a broadcast index signal containing the unique identification number associated with the transceiver and tuning data. Applicant can find no teaching that the "program control information signal" generated by the operations center 202 *contains the unique identification number associated with the set top terminal*. Further specific clarification as to the teachings of this element was respectfully requested in the last Response -- the Advisory Action failed to provide any clarification.

Again (as in Hendricks '350), in Hendricks '131, a set top terminal identifier 928 includes a polling command/response (or P/F) bit 930, that is used for polling purposes -- there is no teaching or suggestion that this identifier 928 is used to monitor and receive, from a wireless communication system, a broadcast index signal containing this unique identifier associated with the receiver. As explained at least at col. 45, lines 42-45 of Hendricks '131, "program access information for each program watched is stored at the set top terminal 220 until it is polled by the network controller 214 for information retrieval using the program control information signal or STTCIS....[this] can be accomplished by using the polling request message and response formats..., but any suitable polling request and response message format may be used to

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interrogate each set top terminal 220 sequentially, one by one...[t]he set top terminals 220 are identified by a unique address and set top terminal identifier”.

Again, Applicant respectfully submits that Hendricks ‘131 fails to teach or suggest receiving a broadcast index signal containing the unique identification number associated with the transceiver and tuning data.

#### Independent Claim 14

Independent Claim 14 is directed to a method for requesting and receiving designated information in a broadcast system, at a first transceiver having a unique identification number, the method reciting the steps of Claim 7, and also the additional step of *transmitting at least a portion of the stored tuning data from the first transceiver to a second transceiver*.

As described above (with respect to Hendricks ‘350), Applicant respectfully submits that Hendricks ‘131 similarly fails to teach or suggest a method in accordance with Claim 7, in which a transceiver receives from a wireless communication system only broadcast index signals containing the *unique identification number associated with the receiver*. While the section of Hendricks ‘131 that describes the program control information signal (col. 41, line 48 – col. 45, line 20) may note that an ‘event ID’ or ‘global channel ID’ is included in TABLE B, it does *not* teach or suggest that the transceiver receives from the wireless communication system a broadcast index signal *containing the unique identification number* associated with the receiver and tuning data, and stores only the corresponding tuning data in memory.

For at least the foregoing reason, Applicant respectfully submits that each of independent Claims 7 and 14 is patentable over Hendricks ‘131.